

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY J. BOLL and GREGORY G. BOLL

Appeal No. 2000-2053
Application No. 08/764,353

ORDER REMANDING TO EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)¹ was amended to provide as follows (underlining added for emphasis):

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all

¹ 60 Fed. Reg. 14518 (Mar. 17, 1995), 1173 Off. Gaz. Pat. & Trademark Office 62 (Apr. 11, 1995).

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other appeals or interference known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. (underlining added for emphasis).

The appeal brief filed March 31, 2000 (Paper No. 21) is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rules pertaining to "Real Party in Interest" and "Related Appeals and Interferences."

The Manual of Patent Examining Procedure (MPEP) § 1206 (6th ed., rev. 1, no. 1, Sept. 1995) states:

While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest. See MPEP § 1210.01.

If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

The examiner may presume that the party named in the caption of the brief is the real party in interest and that there are no related appeals and interferences, if appellants present the heading but fails to provide the corresponding statement under the heading. Nevertheless, the examiner is encouraged to request from appellants not only the required headings but also explicit statements identifying the real party in interest and any related

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appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require appellants to explicitly identify the real party in interest and any related appeals and interferences.

Additionally, in accordance with the amendment filed August 17, 1999 (Paper No. 15), it is noted that the appeal brief filed March 31, 2000 (Paper No. 21), is defective, for it no longer contains an accurate appendix of claims 1 and 17 pursuant to 37 CFR § 1.192(c)(9). The following errors are noted.

Claim 1, lines 5-6, delete "electrically conducting lines formed on said insulating surface, said electrically conducting lines making connections with";

line 7, delete "additional";

line 8, insert --components and said probe wires by electrically conducting lines formed on said insulating surface of said epoxy material, said connections are being made between said--.

Claim 17, lines 5-6, delete "electrically conducting lines formed on said insulating surface making connections with" and insert --electrical--;

line 6, delete "additional";

line 7, insert --electrical conductors and said probe wires on said insulating surface of said epoxy material, said connections are being made between said--.

Lastly, in the final rejection (Paper No. 16), filed October 18, 1999, the examiner has listed the D'Souza reference in a rejection over the claims. In the examiner's answer, filed May

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15, 2000 (Paper No. 22), the examiner had not listed or discussed, as prior art (paragraphs (9) and (10)), the D'Souza reference. There is no indication that this reference was withdrawn from consideration. If the D'Souza reference is not withdrawn, the examiner must submit a supplemental examiner's answer listing the D'Souza reference as prior art.

Accordingly, it is

ORDERED that this application be remanded to the examiner to: 1) notify appellants that the brief (Paper No. 21) is defective; 2) notify appellants to correct the brief (Paper No. 21) by submitting a supplemental brief indicating the "Real Party in Interest" and "Related Appeals and Interferences"; and a correct copy of the appendix of claims 1 and 17; 3) provide a supplemental examiner's answer clarifying the status of the D'Souza reference; and 4) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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